



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,465	04/13/2000	Robert F. Bencini	15916-261	7431

7590 10/02/2007
Henricks Slavin & Holmes LLP
840 Apollo Street
Suite 200
El Segundo, CA 90245

EXAMINER

SCHELL, LAURA C

ART UNIT	PAPER NUMBER
----------	--------------

3767

MAIL DATE	DELIVERY MODE
-----------	---------------

10/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/548,465	Applicant(s) BENCINI ET AL.	
	Examiner Laura C. Schell	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-48, 50-54, 65, 66, 68-71, 73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-48, 50-53, 65, 68-71, 73 and 74 is/are rejected.
- 7) ☒ Claim(s) 54, 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The indicated allowability of claims 45, 46, 52-54, 65, 66, 68-71, 73 and 74 are withdrawn in view of the newly applied reference, Lundquist et al. Rejections based on the newly applied reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6, for example), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (distal portion is the portion labeled as 150); an anchoring member (Fig. 4 discloses that the very distal portion comprises an anchoring member which 260 is attached to) associated with the distal portion of the elongated body and secured to the steering wire (the anchoring

member is secured to the steering wire via 260. Please note that the claim language does not require the anchoring member to be directly secured to the steering wire); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body and defining a distal end, the distal end of the stiffening member being directly secured to the anchoring member (Fig. 4 discloses the stiffening member and anchoring member being secured together at the very distal-most end); and a tubular member (Figs. 2-4, 190) that is a partial circle in cross section (Figs. 2-3 disclose that 190 is a partial circle in cross section due to the slit in its cross section) and has a slot (220) positioned relative to the stiffening member so as to prevent the stiffening member from tearing through the elongated body when the stiffening member bends (190 constitutes the same device as the applicant's anti-tear device, and furthermore, provides the same function of the anti-tear device, to spread out the force and stress placed on the steering wire).

In reference to claim 46, Lundquist discloses that a portion of the steering wire is positioned within the slot (Figs. 2 and 3).

Claims 47, 48, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6, for example), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160)

including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a stiffening member associated with the distal portion of the elongate body (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members); an anti-tear device (190) positioned adjacent to at least a portion of the stiffening member (Figs. 2-4) and configured to prevent the stiffening member from tearing through the elongate body when the stiffening member bends (190 constitutes the same device as the applicant's anti-tear device, and furthermore, provides the same function of the anti-tear device, to spread out the force and stress placed on the steering wire); and a steering wire (120/150), which is not connected to the anti-tear device and which is not located within the stiffening member (Figs. 2-4 disclose that the steering wire is attached to the stiffening member, not located within the stiffening member), having a distal portion operably connected to the distal portion of the elongate body (Fig. 4 discloses that the very distal portion comprises an anchoring member which the steering wire is attached to via 260; please note that the claim language does not state that the steering wire must be directly attached to the elongate body).

In reference to claim 48, Lundquist discloses that the anti-tear device is secured to the stiffening member (via 220).

In reference to claims 50 and 51, Lundquist discloses that the anti-tear device comprises a tubular member (190 is tubular) and comprises a slot (220).

Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6) comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (distal portion is the portion labeled as 150) operably connected to the distal portion of the elongate body (the steering wire is connected to the elongate body via its connection to 260 as 260 is connected to the very distal end of the elongate body as seen in Fig. 4. Please note that the claim language does not require the steering wire to be directly connected to the elongate body); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body; and a substantially c-shaped anti-tear device (anti-tear device is 190; Figs. 2 and 3 disclose that because of the slot 220, the anti-tear device has a c-shape; 190 constitutes the same device as the

applicant's anti-tear device, and furthermore, provides the same function of the anti-tear device, to spread out the force and stress placed on the steering wire); wherein a portion of the steering wire is positioned within the slot (Figs. 2 and 3).

In reference to claim 53, Lundquist discloses that the elongate body defines a longitudinal axis and the stiffening member (260) extends less than entirely around the longitudinal axis (Figs. 2 and 3 clearly show that the stiffening member does not extend entirely around the longitudinal axis).

Claim 65 is rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (distal portion is the portion labeled as 150) operably connected to the distal portion of the elongate body (the steering wire is connected to the elongate body via its connection to 260 as 260 is connected to the very distal end of the elongate body as seen in Fig. 4. Please note that the claim language does not require the steering wire to be directly connected to the elongate body); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening

member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body and defining a proximal end; and an anti-tear device (190 constitutes the same device as the applicant's anti-tear device, and furthermore, provides the same function of the anti-tear device, to spread out the force and stress placed on the steering wire), defining a proximal end (near 120) and a distal end (near 150), secured to the proximal end of the stiffening member (secured via slot 220) such that the proximal end of the anti-tear device is located within the distal portion of the elongate body (Figs. 2-4); wherein the elongate body defines a distal end (near 160) and at least a portion of the stiffening member is located proximal of the distal end of the elongate body (Figs. 2-4); and wherein the steering wire is not directly connected to the anti-tear device (Figs. 2 and 3 disclose that the steering wire is not directly connected to the anti-tear device).

Claim 68 is rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260)

Art Unit: 3767

are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body (Fig. 4) such that the stiffening member will apply a force over an elongate body surface area when the stiffening member is bent (Figs. 3 and 4); anti-tear means (190 constitutes the same device as the applicant's anti-tear device, and furthermore, provides the same function of the anti-tear device, to spread out the force and stress placed on the steering wire), associated with the stiffening member (via slot 220), for increasing the elongate body surface area over which the force is applied when the stiffening member is bent to prevent the stiffening member from tearing through the elongate body (Figs. 2-4); and a steering wire (120/150), which is not connected to the anti-tear means, having a distal portion operably connected to the distal portion of the elongate body (connected to the elongate body via its connection to 260 as 260 is connected to the very distal end of the elongate body as seen in Fig. 4. Please note that the claim language does not require the steering wire to be directly connected to the elongate body); wherein the stiffening member and the distal portion of the steering wire are substantially diametrically opposed from one another (Fig. 2 discloses an attachment point at 260 where it can be said that they are diametrically opposed, as the claims do not specify with respect to what diameter they are diametrically opposed).

Claims 69, 73 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal

Art Unit: 3767

portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (near the distal end of 260); an anchoring member (Fig. 25, discloses anchoring members as 390; please note that the claim language does not require any further structure of the anchoring member, and therefore the welding points/joints 390 anticipate the claim language) associated with the distal portion of the elongate body and secured to the steering wire (390 are located at the distal portion and are directly secured to the steering wire (360/370 in Fig. 25); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body (Fig. 4) and defining a distal end (Fig. 4), the distal end of the stiffening member being directly secured to the anchoring member (Figs. 25 discloses that the stiffening member is directly secured to the anchoring member 390); and a substantially tubular member (190) secured to the stiffening member (secured via 220) and defining a continuous length in a direction parallel to the longitudinal axis (Figs. 2 and 3) and a wall thickness, the continuous length being substantially greater than the wall thickness (Figs. 2 and 3 disclose that the length of 190 is longer than the wall thickness); wherein the wire is movable relative to the substantially tubular member (Figs. 2 and 3 disclose that the steering wire is not

connected to the tubular member and Fig. 3 in particular discloses that the wire is movable relative to tubular member both longitudinally and radially).

In reference to claim 73, Lundquist discloses a handle (Fig. 1, 110) operably connected to the elongate body and to the steering wire, adapted to pull the steering wire relative to the elongate body (col. 5, line 67 through col. 6, line 2).

In reference to claim 74, Lundquist discloses that the steering wire extends to the proximal portion of the elongate body and is movable relative to the proximal portion of the elongate body (col. 5, line 67 through col. 6, line 2).

Claim 70 is rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (near the distal end of 260); an anchoring member (Fig. 25, discloses anchoring members as 390; please note that the claim language does not require any further structure of the anchoring member, and therefore the welding points/joints 390 anticipate the claim language) associated with the distal portion of the elongate body and secured to the steering wire (390 are located at the distal portion and are directly secured to the steering wire (360/370 in Fig. 25); a

Art Unit: 3767

stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body (Fig. 4) and defining a distal end (Fig. 4), the distal end of the stiffening member being directly secured to the anchoring member (Figs. 25 discloses that the stiffening member is directly secured to the anchoring member 390); and a substantially tubular member (190), including a slot (220), secured to the stiffening member (secured via 220) and defining a continuous length in a direction parallel to the longitudinal axis (Figs. 2 and 3) and a wall thickness, the continuous length being substantially greater than the wall thickness (Figs. 2 and 3 disclose that the length of 190 is longer than the wall thickness).

Claim 71 is rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist et al. (US Patent No. 5,336,182). Lundquist discloses an apparatus (Figs. 1-6), comprising: an elongated body (Fig. 1, generally labeled as 30) defining a proximal portion (near 80) and a distal portion (near 160) including a wall defining an inner surface (Fig. 4 discloses the inner surface of 30), an outer surface (Fig. 4 discloses the outer surface of 40) and a lumen extending from the proximal portion to an aperture in the distal portion (Fig. 35 discloses an embodiment with a lumen leading to an aperture); a steering wire (120/150) having a distal portion (near the distal end of 260); an anchoring member (Fig. 25, discloses anchoring members as 390; please note that the claim language does not require any further structure of the anchoring member, and

Art Unit: 3767

therefore the welding points/joints 390 anticipate the claim language) associated with the distal portion of the elongate body and secured to the steering wire (390 are located at the distal portion and are directly secured to the steering wire (360/370 in Fig. 25); a stiffening member (260 is clearly stiffer than the flexible catheter in which it resides as Lundquist discloses that the steering wire (150) and stiffening member (260) are soldered together therefore disclosing that these are two metal members) associated with the distal portion of the elongate body (Fig. 4) and defining a distal end (Fig. 4), the distal end of the stiffening member being directly secured to the anchoring member (Figs. 25 discloses that the stiffening member is directly secured to the anchoring member 390); and a substantially tubular member (190), which extends less than completely around the longitudinal axis (Figs. 2 and 3 disclose that the tubular member does not extend completely around the longitudinal axis because of slot 220), secured to the stiffening member (secured via 220) and defining a continuous length in a direction parallel to the longitudinal axis (Figs. 2 and 3) and a wall thickness, the continuous length being substantially greater than the wall thickness (Figs. 2 and 3 disclose that the length of 190 is longer than the wall thickness).

Allowable Subject Matter

Claims 54 and 66 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see pages 9-10, filed 9/10/2007, with respect to the previously used Ebling reference have been fully considered and are persuasive. The rejection of claims 20, 21, 24, 43, 44 and 69-75 has been withdrawn.

Upon reviewing all previously cited references, both by the examiner and the Applicant, prior to allowing the application, it was determined that the above applied Lundquist reference (previously cited in one of Applicant's IDS forms), can still be applied to the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Schell whose telephone number is (571) 272-7881. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LCS

LCS

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

Kevin C. Sirmons